

REMARKS

Claims 1-36 are pending in the application.

Claims 1, 2, 9-15, 18-23, 26-31, 33, 34, and 36 have been rejected.

Claims 3-8, 16, 17, 24, 25, 32, and 35 are objected to.

No claims have been amended.

Reconsideration and full allowance of Claims 1-36 are respectfully requested.

I. PENDING CLAIMS

As an initial matter, the Applicant notes that the Office Action inadvertently lists Claims 1-38 as pending in this case. (*Office Action, Page 1*). The Applicant respectfully notes that only Claims 1-36 are currently pending.

II. OBJECTION TO SPECIFICATION

The Office Action objects to the specification because it does not contain serial numbers for two related patent applications. The Applicant has amended the specification to include the serial numbers of the related applications.

The Applicant also amended the title of one of the related applications. The title of the related application appears to have been incorrectly noted in this application at the time of filing. However, the attorney docket number, inventors, and filing date were correct. Based on this information, the correct related application could have been easily identified.

With the amendments to the specification, the Applicant respectfully requests withdrawal of the objection.

III. ALLOWABLE CLAIMS

The Applicant thanks the Examiner for the indication that Claims 3-8, 16, 17, 24, 25, 32, and 35 would be allowable if rewritten in independent form to incorporate the elements of their respective base claims and any intervening claims. Because the Applicant believes that the remaining claims in this application are patentable, the Applicant has not rewritten these claims in independent form.

IV. REJECTION UNDER 35 U.S.C. § 103

The Office Action rejects Claims 1, 13-15, 18-19, 21-23, 26-27, 29-31, 33-34, and 36 under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 5,909,564 to Alexander et al. ("*Alexander*") in view of U.S. Patent Application Publication 2003/00048864 to Michels et al. ("*Michels*"). The Office Action rejects Claims 2 and 9-10 under 35 U.S.C. § 103 as being unpatentable over *Alexander* and *Michels* in further view of U.S. Patent No. 6,128,296 to Daruwalla et al. ("*Daruwalla*"). The Office Action rejects Claims 11-12, 20, and 28 under 35 U.S.C. § 103 as being unpatentable over *Alexander* and *Michels* in further view of U.S. Patent No. 5,621,908 to Akaboshi et al. ("*Akaboshi*"). These rejections are respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260,

1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2142.

Alexander recites an Ethernet switch that includes multiple Medium Access Control (MAC) interface logic circuits coupled to multiple output ports. (*Abstract*). The Ethernet switch also includes a switch central processor. (*Abstract*). The central processor executes firmware to provide various functions in the Ethernet switch, such as firmware for reading the contents of counters, classifying frame lengths, and performing counter updates for remote monitoring. (*Col. 2, Lines 6-10*). *Alexander* recites that multiple Ethernet switches can be coupled together and communicate with one another, such as by exchanging “information regarding their address tables.” (*Col. 10, Lines 44-47*).

Regarding Claim 1, *Alexander* simply recites an Ethernet switch that implements various functions in firmware instead of hardware. *Alexander* also recites that multiple Ethernet switches may communicate with one another. *Alexander* does not disclose, teach, or suggest “retrieving” a “list of locally owned address information” from “each of [a plurality of] distributed address databases,” where each address database includes “locally owned address entries” and “remotely owned address entries” as recited in Claim 1.

While *Alexander* recites that the Ethernet switches may exchange “information regarding their address tables,” *Alexander* contains no recitation that each address table includes “locally owned address entries” and “remotely owned address entries.” In particular, *Alexander* fails to specify what information is exchanged between the Ethernet switches “regarding their address tables.”

Because *Alexander* does not expressly describe the information that is contained in the address tables or that is exchanged between the Ethernet switches “regarding their address

tables,” the burden is on the Patent Office to show that *Alexander* inherently discloses an address database including “locally owned address entries” and “remotely owned address entries.” However, it is not enough for the Patent Office to show that “a certain result or characteristic may occur or be present in the prior art.” (*MPEP* § 2112). To establish inherency, the burden is on the Patent Office to show that “the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.” (*MPEP* § 2112).

The Office Action has not shown that the Ethernet switches of *Alexander* each includes an address database having “locally owned address entries” and “remotely owned address entries” as recited in Claim 1. The mere fact that the Ethernet switches exchange information “regarding their address tables” does not establish that each address table has “locally owned address entries” and “remotely owned address entries.” In particular, the Applicant notes that *Alexander* recites the Ethernet switches exchange information “regarding” their address tables, not information “from” their address tables or information “contained in” their address tables. Each Ethernet switch could simply inform the other switches as to the size of its address table or the time at which the address table was last updated.

The Office Action contains no explanation as to why the Ethernet switches in *Alexander* “must” operate using an address database having “locally owned address entries” and “remotely owned address entries” as recited in Claim 1. As a result, the Office Action has not shown that *Alexander* discloses, teaches, or suggests these elements of Claim 1.

Michels is cited by the Office Action only as allegedly showing that network addresses may be sorted. The Office Action cites no portion of *Michels* as disclosing, teaching, or suggesting the use of an address database having “locally owned address entries” and “remotely owned address entries” as recited in Claim 1.

For these reasons, the Office Action does not show that the proposed *Alexander-Michels* combination discloses, teaches, or suggests the Applicant’s invention recited in Claim 1 (and its dependent claims).

Claims 14, 22, 30, 33, and 36 all recite the use of an “address database” that includes “locally owned address entries containing locally owned address information” and “remotely owned address entries containing remotely owned address information.” As described above, the Office Action has not established that the Ethernet switches of *Alexander* use an “address database” that includes “locally owned address entries” and “remotely owned address entries.” The Office Action also does not rely on *Michels* as disclosing, teaching, or suggesting these elements of Claims 14, 22, 30, 33, and 36.

For these reasons, the Office Action does not show that the proposed *Alexander-Michels* combination discloses, teaches, or suggests the Applicant’s invention as recited in Claims 14, 22, 30, 33, and 36 (and their dependent claims).

Accordingly, the Applicant respectfully requests withdrawal of the § 103 rejection and full allowance of Claims 1, 2, 9-15, 18-23, 26-31, 33, 34, and 36.

V. **CONCLUSION**

As a result of the foregoing, the Applicant asserts that the remaining claims in the application are in condition for allowance and respectfully requests an early allowance of such claims.

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If any issues arise, or if the Examiner has any suggestions for expediting allowance of this application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *rmccutcheon@davismunck.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Davis Munck Deposit Account No. 50-0208.

Respectfully submitted,

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